REMARKS

In reply to the Office Action mailed September 12, 2008, Applicants amended claim 7. This amendment complies with 37 CFR §1.116. Applicants present claims 1-17 and 20-27 for examination.

The Examiner objected to claim 7. Applicants amended claim 7 to obviate the objection, so the objection should be withdrawn.

The Examiner rejected claims 23 and 27 under 35 U.S.C. §102(b) as being anticipated by Fujimori. These claims require a support layer supported by a substrate and an electrode supported by the support layer. Applicants do not concede that the Examiner has properly characterized the subject matter disclosed in Fujimori. However, even under the Examiner's interpretation of Fujimori, because Fujimori's electrode 3 is between substrate 2 and barrier layer 8, it cannot be correctly be said that barrier layer 8 is supported by substrate 2 while at the same time saying that electrode 3 is supported by barrier layer 8. Applicants therefore request reconsideration and withdrawal of this rejection.

The Examiner rejected claims 1-15, 21 and 22 under 35 U.S.C. §103(a) as being unpatentable over Fujimori in view of Tiedje, alone or further in view of Nakamura. But, as would be readily understood by one skilled in the art, Fujimori discloses only processes in which or making his device in which the semiconductor layer would have the same general degree of structure as the substrate. As would also be understood by one skilled in the art, Tiedje also discloses only processes in which or making his device in which the semiconductor layer would have the same general degree of structure as the substrate. Thus, even if Fujimori and Tiedje were somehow combined, the result would be a device in which the semiconductor layer would have the same general degree of structure as the substrate, not a device having a substrate with structured surface and a semiconductor layer with a planar surface. As a result, the Examiner should provide evidence regarding how the prior art would have enabled one skilled in the art to modify the processes of Fujimori and/or Tiedje to provide a device having a substrate with structured surface and a semiconductor layer with a planar surface. (*See, e.g.*, *Beckman*

Instruments, Inc. v. LKB Produkter AB, 892 F.2d 1547, 1551 (Fed. Cir. 1989) ("In order for the prior art to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method.") The Examiner has not provided such evidence. Instead, the Examiner relies on paragraph [0363] of Fujimori as supporting the notion that "Fujimori discloses that the reference is open to ***any*** kind of modification without departing from the scope of the invention." (Office Action, p. 17, emphasis provided.) Even if the Examiner had accurately characterized this paragraph of Fujimori, the Examiner still would not have demonstrated that the prior art would have enabled one skilled in the art to modify the methods of Fujimori and/or Tiedje to provide a substrate with structured surface and a semiconductor layer with a planar surface. But, the Examiner actually mischaracterized paragraph [0363] of Fujimori. What this paragraph of Fujimori actually discloses is:

> Finally, it is to be understood that the present invention is not limited to the embodiments and examples described above, and ***many*** changes or additions may be made without departing from the scope of the invention which is determined by the following claims. (Fujimori, [0363], emphasis provided.)

Thus, what Fujimori actually discloses is quite different from what the Examiner said Fujimori discloses. Nakamura does not cure the deficiencies of the combination of Fujimori and Tiedje. Thus, Applicants request reconsideration and withdrawal of this rejection.

The Examiner rejected claims 23-25 and 27 under 35 U.S.C. §103(a) as being unpatentable over Fujimori in view of Tiedje, alone or further in view of Shinohara. For reasons similar to those noted above, the combination of Fujimori and Tiedje does not render obvious the subject matter covered by claims 23-25 and 27. Further, the Examiner has not provided evidence regarding how the prior art would have enabled one skilled in the art to modify the processes of Fujimori and/or Tiedje to provide the subject matter covered by these claims, and Shinohara does not cure the deficiencies of Fujimori and Tiedje. Thus, Applicants request reconsideration and withdrawal of this rejection.

The Examiner rejected claims 16, 17 and 20 under 35 U.S.C. §103(a) as being unpatentable over Fujimori in view of Shinohara. For reasons similar to those noted above,

Fujimori does not disclose or render obvious the subject matter covered by these claims. Shinohara does not cure Fujimori's deficiencies. Moreover, the Examiner has not provided evidence regarding how the prior art would have enabled one skilled in the art to modify the processes of Fujimori and/or Shinohara to provide the subject matter covered by these claims. Applicants therefore request reconsideration and withdrawal of this rejection.

The Examiner rejected claims 23-26 under 35 U.S.C. §103(a) as being unpatentable over Fujimori in view of Shinohara, alone or further in view of Tiedje. For reasons similar to those noted above, Fujimori does not disclose or render obvious the subject matter covered by these claims. Shinohara does not cure Fujimori's deficiencies. Further, the Examiner has not provided evidence regarding how the prior art would have enabled one skilled in the art to modify the processes of Fujimori and/or Shinohara to provide the subject matter covered by these claims. Tiedje does not cure the infirmities of the combination of Fujimori and Shinohara. Therefore, Applicants request reconsideration and withdrawal of this rejection.

Please apply any charges or credits to deposit account 06-1050, referencing Attorney Docket No. 21928-017US1.

Respectfully submitted,

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